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Attorney Docket No. 06502.0340-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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Michael SIJACIC et al.) Group Art Unit: 3627
)
Serial No.: 09/867,652) Examiner: S. McAllister
)
Filed: May 31, 2001) Confirmation No.: 7976
)
For: METHODS AND SYSTEM FOR)
PERFORMING ELECTRONIC)
INVOICE PRESENTMENT AND)
PAYMENT DISPUTE HANDLING)
WITH LINE ITEM LEVEL)
GRANULARITY)

Mail Stop Amendment

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated October 8, 2004, the Examiner required restriction under 35 U.S.C. § 121 between claims 1-14, 21-25, and 31-35 (Group I), claims 15-20, 26-30, and 55-68 (Group II), and claims 36-54 (Group III).

Applicants provisionally elect to prosecute Group I, claims 1-14, 21-25, and 31-35 with traverse.

I. Groups I and II are not Distinct

The Examiner asserts that Groups I and II are distinct because they are directed to a process and apparatus for its practice. To establish that these groups are distinct,

the Examiner must show one-way distinctness and provide reasonable examples that recite material differences between the two groups. See M.P.E.P. § 806.05(e). In particular, the Examiner must show either that the claimed process can be practiced by another materially different apparatus or by hand, or (2) the claimed apparatus can be used to practice another and materially different process. *Id.* The Examiner has failed to meet this burden.

a. The Examiner Did not Provide Reasonable Examples that Recite Material Differences

The Examiner asserts that the two groups of claims are distinct because “apparatus can be used as a general computer.” This position does not meet the requirements of M.P.E.P. § 806.05(e). Whether the claimed “apparatus can be used as a general computer” is irrelevant to show the claimed process can be practiced by another materially different apparatus or that the apparatus can be used to practice another materially different process. Indeed, the Examiner’s statement does not address the requirements of § 806.05(e). See Restriction, page 2, lines 11-15.

Further, even assuming that the Examiner’s position is that the apparatus may be a “general computer,” such interpretation does not meet the standard of § 806.05(e). For example, the processes recited in claims 1-14, 21-25, and 31-35 may be performed by a “general computer.” Accordingly, these processes may be performed by the same type of “computer” that may be used in claims 15-20, 26-30, and 55-68, as asserted by the Examiner. As such, the Examiner’s position fails to show the claimed process can be practiced by a materially different apparatus. Alternatively, if the Examiner asserts that the apparatus is a “general computer” that can be used to practice another materially different process, the Examiner has failed to reasonably identify that process,

as required by M.P.E.P. § 806.05(e). Additionally, the Examiner has failed to explain how the systems recited in claims 15-20, 26-30, and 55-68 can be construed as merely a “general computer” in light of the claims’ recitations.

Based on the above, Applicants traverse the Examiner’s position that Groups I and II are distinct, and request that claims 1-35 and 55-68 be examined as a single invention.

b. The Examiner Must Examine Claims 55-68 with Elected Claims 1-14

Notwithstanding the above arguments, the Examiner is required to examine claims 55-68 with elected claims 1-14. Claims 55-68 recite recitations similar to those of claims 1-14 in means-plus-function language. M.P.E.P. § 806.05(e) states, “[i]f the apparatus claims include a claims to ‘means’ for practicing the process, this claim is a linking claim” and the “linking claims must be examined with the elected invention.” Because claims 55-88 recite “means” for practicing the methods of elected claims 1-14, the Examiner is required to examine 55-68 with the elected claims.

II. Groups I and III are not Distinct

There is no material difference between claims 1-14 of Group I and claims 36-49 of Group II. In fact, they recite the identical processes. Each of claims 36-49 recites a computer-readable medium including instructions for performing a method that includes the same steps as those recited in claims 1-14, respectively. The Examiner has not provided a “reasonable” example that recites material differences between the two groups.

Further, the Examiner asserts that Groups I and III are distinct because the “method can be practiced by hand.” See Restriction, page 3, line 2. Applicants

disagree with the Examiner's position. Claims 31-35 are not performed by hand because they recite "computer-implemented" methods. Such recitations clearly distinguish the claims from being a process merely performed by hand. As such, the Examiner's position regarding these claims is improper as it contradicts the plain language of the claim.

III. Groups II and III are not Distinct

a. Groups II and III do not Have Separate Utility

The Examiner attempts to show distinctness by stating that Groups II and III are subcombinations usable together and have separate utility, such as "a general computer." See Restriction, page 3, lines 3-6. Applicants disagree with the Examiner. The Examiner's exemplary utility is so broad as to encompass many types of systems and processes that may be implemented by the various embodiments of the present invention. Nonetheless, the Examiner's hypothetical subcombination utility applies to the very subcombination the Examiner is attempting to distinguish. That is, according to the Examiner, the utility of Group II (i.e., "a general computer") is separately usable than the "**computer**-readable medium" recitations of claims 36-54. This position is clearly unsupported by Applicants' claimed invention because it contradicts the plain language of the claims. That is, if the utility of claims 15-20, 26-30, and 55-68 is directed to a "general computer," clearly this utility would meet the utility of a computer-readable medium that includes instructions that perform a method when executed by a processor. Accordingly, there can be no separate utility of Groups II and III, as asserted by the Examiner.

b. The Asserted Groupings are not Divergent Classified Subject Matter

The Examiner attempts to show distinctness by asserting that Groups I1 and III have separate utility and that they are directed to subject matter classified in divergent classes/subclass combinations. Applicants disagree. The Examiner has classified claims that include identical recitations in different subclasses. For example, the Examiner classifies claim 15 of Group II in class 700, subclass 1, while classifying its counterpart computer-readable medium claim 50 in class 705, subclass 8. The Examiner's classifications are clearly incorrect and are an indication of the inconsistent reasoning for restricting claims 15-20, 26-30, 55-68 and 36-54. The inconsistency in these classifications cannot be reconciled.

Claims 1-68 are all directed to a single invention with varying scopes. Any attempts to classify the claims in different subclasses is improper. For example, the Examiner improperly asserts that Group II is directed to apparatuses used in "dispute resolution methods, classified in class 700, subclass 1 and Group III is classified in class 705, subclass 8. The Examiner's classifications are improper. For instance, class 700, subclass 1 is directed to "[s]ubject matter wherein there is a combination of a data processing or calculating computer apparatus (or corresponding method for performing data processing or calculating operation) and a device or apparatus controlled thereby, the entirety hereinafter referred to as a control system." See Manual of Classification, Class 700, Subclass 1. Further, the Manual of Classification states,

[a]n example of such a control system includes a data processing or calculating computer interactively connected to an external device to sense a condition (e.g., position) of such external device. The processed data representing the sensed condition develops a control signal to be applied to

such external device to perform a general applicability control function (e.g., optimization). *Id.*

Nowhere has Applicants claimed or sought protection for control systems, as defined by class 700. Instead, claims 1-68 are directed to methods, systems, and computer-readable mediums associated with dispute resolution processes consistent with certain aspects related to Applicants' invention. Class 700 is clearly not the proper classification for such claims.

Because, the Examiner's asserted classification is improper, and the claims in Groups II and III are directed to the same invention, the Examiner failed to show any undue burden in examining claims 15-20, 26-30, 36-54, and 55-68 collectively. Accordingly, these claims should be examined as a single invention.

IV. Conclusion

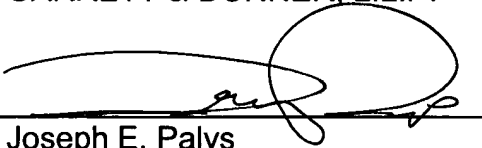
Applicants are not required to draft each claim with identical terms and phrases to avoid a restriction. A proper review of claims 1-68 shows that these claims are directed to a single invention with varying scopes. Accordingly, Applicants respectfully request that the Examiner withdraw the restriction of claims 1-68 as proposed in the Office Action dated October 8, 2004 and continue the examination of these claims as a single invention.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: 
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